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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/441,142	11/12/99	MURRAY	94111-3834

EXAMINER: BOUCHER, D

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ART UNIT	PAPER NUMBER
3627	12

DATE MAILED: 09/25/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on ~~August~~ July 3, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 56-65, 71-82 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 56-65, 71-82 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☒ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____.
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 11
☐ Interview Summary, PTO-413
☐ Notice of Draftperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement filed November 12, 1999 fails to comply with the provisions of 37 CAR 1.97, 1.98 and MPEP § 609 because applicants have failed to provide a copy of the foreign references and other art along with a statement of their pertinence. Although these references are cited in another application that application is not available to the Examiner. The Examiner has considered the U.S. references since those are readily available. No additional fee is due. Applicants need only send in copies of the foreign references and the other art and they will be considered by the Examiner.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 56-65, drawn to a locking device for portable computer equipment, classified in class 70, subclass 58.

II. Claims 66-70, drawn to a method of inhibiting theft of a portable object, classified in class 70, subclass 18.

III. Claim 83, drawn to a locking device for portable computer equipment, classified in class 70, subclass 58.

3. The inventions are distinct, each from the other because of the following reasons: Inventions I and III and II are related as process of making and process of using the product. The use as claimed cannot be practiced with a materially different product. Since the product is not

allowable, restriction is proper between said method of making and method of using. The product claim will be examined along with the elected invention (MPEP § 806.05(I)).

4. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different patentably distinct species of the same invention. See figures 14,15 and 27B.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Michael Woods on March 23, 2000 a provisional election was made with traverse to prosecute the invention of Figures 14-15, claims 56-65 and 67-82. Affirmation of this election must be made by applicant in replying to this Office action. Claims 66-70 and 83 are withdrawn from further consideration by the examiner, 37 CAR 1.142(b), as being drawn to a non-elected invention.

7. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CAR 1.48(b) if one or more of the currently named inventors are no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CAR 1.48(b) and by the fee required under 37 CAR 1.17(I).

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 56-65 and 71-82 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sloop, Sr. 4,704,881. Sloop, Sr. teaches all the elements of the claimed invention including housing 66, moveable locking arm 62 with locking member 64, pin 76, and cable (shackle of padlock) for attachment to an object other than to the portable object (the body of the padlock 24 or the locking device itself). Sloop, Jr. teaches use of his barrel lock assembly with a conventional padlock. It is inherent in the prior art disclosure of Sloop, Jr that any conventional padlocks including those that have a flexible cable shackle are useable. In the alternative, the Examiner takes OFFICIAL NOTICE that padlocks having

flexible cable shackles are well known. See Foote 3,765,197. It would have been obvious to one of ordinary skill in the art to use any conventional padlock including those that have a flexible cable shackle with the Sloop, Jr. barrel lock assembly. The curved contour of abutment 64 is considered to fit together/match/correspond to a curved periphery of the apertures 44,42. The lock housing of Sloop, Sr. is a portable object which is prevented from being removed when in the locked position. Sloop, Sr. also teaches locking member 64 being maneuvered with slight angular or rotative movements until it engages the wall of the lock retaining means 38. See column 3, lines 38-43.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CAR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CAR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CAR 3.73(b).

12. Claims 56-65 and 71-82 are provisionally rejected under the judicially created doctrine of double patenting over any claims of any copending Applications which claim the same subject matters set forth in the claims of this application and claim the benefit of earlier filing date under 35 USC 120 over all applications listed on page 1 of applicant's disclosure and any other

copending cases not listed which claim the benefit of earlier filing under 35 USC 120 of any applications listed on page 1 of applicant's disclosure. Because applicants are in a better position to know what applications are pending at the time of response to this office action and what is being claimed in those applications, applicants' shall provide such information for the which the Examiner will verify if the application is in condition for allowance. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: a locking device with a locking member which locks down a piece of portable equipment having an aperture corresponding to the locking member with a cable.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804. Although restrictions and election of species have been made in several of applicants' copending applications, at least claim 56 of the current case is generic to several embodiments.

13. Claims 56-65 and 71-82 are rejected under the judicially created doctrine of double patenting over any claims of any U. S. Patents granted to applicants' which claim the same subject matter set forth in the claims of this application and claim the benefit of earlier filing date under 35 USC 120 over all applications which matured into patents listed on page 1 of applicant's

disclosure and any other copending applications which have matured into patents not listed which claim the benefit of earlier filing under 35 USC 120 of any applications listed on page 1 of applicant's disclosure, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent. Because applicants are in a better position to know what applications have matured into patents at the time of response to this office action and what is being claimed in those patents, applicants' shall provide such information for the which the Examiner will verify if this application is in condition for allowance.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804. Although restrictions and election of species have been made in several of applicants' copending applications, at least claim 56 of the current case is generic to the several embodiments and the Examiner knows of at least U.S. Patent number 5,502,989 which claims the same invention elected in this application.

Applicants are invited to contact the Examiner, if they fail to understand the double patenting rejections being made and what they are required to provide on the terminal disclaimer in order to overcome these rejections.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darnell Boucher whose telephone number is (703) 308-2492.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BethAnne Dayoan, can be reached at (703) 308-3865.

Submission of your response by facsimile transmission is encouraged. Group 3620's facsimile number is **(703) 305-3597**. Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly in our examining group's hands and will eliminate Post Office processing and delivery time as well as the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP § 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a deposit account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) 305-3597) on ____(Date)____

_____
(Typed or printed name of person signing this certificate)

_____
(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CAR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

Any inquiry of a general nature relating to the status of this application should be directed to the group receptionist at (703) 308-2168.

March 25, 2000

DARNELL BOUCHER
PRIMARY EXAMINER